REMARKS

This responds to the Office Action mailed on <u>November 30, 2005</u>.

Claims 2, 25, 43, 65, and 66 are amended, no claims are canceled or added; as a result, claims 1-68 are pending in this application.

§112 Rejection of the Claims

Claims 2, 25, 43 and 60-68 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description or enablement.

Claims 2, 25, 43, 65, and 66 have been rejected as not being enabled. In particular, the Action states that "known behavior of individual users" lacks enablement because there is no disclosure as to how said behavior is known. The Action further states that this rejection will be withdrawn if the claims are amended. While Applicants disagree with the assertion that these claims are not enabled, to ease prosecution, claims 2, 25, 43, 65, and 66 have been amended to replace "determine" with "estimated" and/or to replace "known" with "observed" as suggested in the Action on page 2.

Claims 60-68 have been rejected as not being enabled. In particular, the Action states that there is no enablement for determining an expected number of deliveries based on the expected position. The Action also states that "additional mathematics" used to arrive at the delivery ratio incorporating "DeliveriesExpected" at paragraph 70 is not sufficient.

Applicants respectfully disagree. In particular, paragraph 73 of the current application states multiple tangible mathematic methods that may be used to arrive at the delivery ratio incorporating "DeliveriesExpected":

> "[0073] The DSO could optionally utilize <u>numerical analysis methods</u> to derive the relative importance of each piece of content in the queue list. The over all fitness of a queue ordering is the sum of the values of all of the contracted content deliveries. This value is a differentiable function with respect to the weightings. As a result, the DSO can <u>use multi-dimensional Newton's method or the steepest descent method to rapidly approach an optimal solution.</u>" (Emphasis Added),

In addition, paragraph 70 of the current application recites, in part:

"A so-called Delivery Specification Optimizer (DSO) software module can embody the mathematical properties to adjust the ordering of the queue list. Specifically, the DSO attempts to find a queue list S such that, for each ad A, the "delivery ratio"..." (Emphasis Added).

Because 'determining an expected number of deliveries based on the expected position' has been shown to be enabled in paragraphs 70 to 73 of the current application, Applicants respectfully request withdrawal of this rejection, reconsideration and allowance of these respective claims.

§103 Rejection of the Claims

Claims 1-13 and 15-59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dimitriadis et al. (U.S. 5,664,949) in view of Marsh et al. (U.S. 5,848,397). Applicants respectfully disagree.

The Office Action has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every claim element. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

Applicants respectfully submit that the Office Action did not make out a *prima facie* case of obviousness, because the combined references, and in particular Marsh, do not teach each and every claimed element of independent claims 1, 24, 38, 39, 42, and 56. (A) Marsh, in particular does not teach: "an ordered list... based on the expected values" (e.g., "relating to each user being online") as recited in claims 1, 38, 42, and 56, nor does Marsh teach: "generating an individual list of advertisements... based on user profile data..." as recited in claim 24, nor does Marsh teach: "generating an ordered master list of items... based on the probability data" (e.g., "probability of a given user being online during a given time period") as recited in claim 39. (B) Further, it is respectfully submitted that Marsh does not teach: "determining expected values relating to each user being online during a given time period" as recited in at least claim 1.

(A) In particular, it is respectfully submitted that Marsh, including the weighted scheduling criteria of Marsh, at col. 4, lines 7-15, col. 10, lines 29-38, and col. 13, lines 8-18, does not teach: "an ordered list... based on the expected values" (e.g., "relating to each user

being online") as recited in claims 1, 38, 42, and 56, nor does Marsh teach: "generating an individual list of advertisements... based on user profile data..." as recited in claim 24, nor does Marsh teach: "generating an ordered master list of items... based on the probability data" (e.g., "probability of a given user being online during a given time period") as recited in claim 39.

The weighting constants c1, c2, c3, and c4 of Marsh are referred to in the Action as disclosing "generating the ordered list based on said expected values, where the ordered list is defined by the weighting constants c1, c2, ... of the weighting scheduling criteria." However, in contrast to the currently pending claims, the weighting constants c1, c2, c3, and c4 of Marsh are actually "...time to expiration (tte), time since last seen (tsls), maximum exposures (me) and percent remaining exposures (pre)," respectively. See, for instance, Marsh, column 9, lines 44–49.

For at least the following two reasons, the weighting constants of Marsh do not disclose the above-recited claimed elements of the independent claims. (1) The weighting constants, specifically, time to expiration (tte), time since last seen (tsls), maximum exposures (me) and percent remaining exposures (pre) are simply quite *different* than and distinguishable from "an ordered list... based on the expected values" (e.g., "relating to each user being online") as recited in claims 1, 38, 42, and 56, "generating an individual list of advertisements... based on user profile data..." as recited in claim 24, and/or "generating an ordered master list of items... based on the probability data" (e.g., "probability of a given user being online during a given time period") as recited in claim 39. (2) These weighting constants appear to be directed towards data concerning the individual advertisements, rather than data concerning the user. See also Marsh, col. 11, lines 15-43.

(1) The weighting constants are distinguishable from the above-recited claimed elements of the independent claims. The Action has simply failed to demonstrate a *link* between the weighting constants of Marsh, in particular, time to expiration (tte), time since last seen (tsls), maximum exposures (me) and percent remaining exposures (pre)" *and* the 'expected values' (e.g., "relating to each user being online"), the 'user profile data,' or the 'probability data' (e.g., "probability of a given user being online during a given time period"), as recited in at least one of the independent claims 1, 24, 38, 39, 42, and 56. Therefore, the Action has simply failed to demonstrate that these weighting constants of Marsh are equivalent to the 'expected values', the

'user profile data,' and the 'probability data' of the currently pending claims.

Because all the elements of independent claims 1, 24, 38, 39, 42, and 56 are not found in Marsh, Applicants assume that the Examiner is asserting that these elements are inherent in Marsh. As recited in MPEP § 2112, "In relying upon the theory of inherency, the Examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art," citing Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Applicants respectfully submit that the Office Action has not established a *prima facie* case of inherency. Again, the Action merely asserts that Marsh discloses "generating the ordered list based on said expected values, where the ordered list is defined by the weighting constants c_1, c_2, ... of the weighting scheduling criteria." The Office Action does not assert that the allegedly inherent characteristics ("an ordered list... based on the expected values," e.g., "relating to each user being online", "generating an individual list of advertisements... based on user profile data...," and "generating an ordered master list of items... based on the probability data," e.g., "probability of a given user being online during a given time period") are necessary in Marsh, let alone provide a basis in fact and/or technical reasoning to reasonably support this determination, as required to show inherency.

When a reference is silent about the asserted inherent characteristic, the gap in the reference may be filled with recourse to extrinsic evidence of record. But, such evidence must make clear that "the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Because there is no evidence in the record to support such inherency assertions, the unsupported assertions appear to be personal knowledge of the Examiner. The Examiner is thus respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Without the requisite extrinsic evidence, the Office Action has not made out a *prima facie* case of anticipation. Accordingly, independent claims 1, 24, 38, 39, 42, and 56 are patentable over Marsh, and Applicants respectfully request that the rejection be withdrawn.

(2) The weighting constants of Marsh are directed towards data concerning the individual

advertisements, rather than data concerning the user. See Marsh, col. 11, lines 15-43. Because the weighting constants are directed towards "characteristics of the advertisements" (see Marsh, col. 9, lines 40-49), the weighting constants simply cannot be relied upon for equivalency to the 'expected values' (e.g., "relating to each user being online"), the 'user profile data,' and the 'probability data' (e.g., "probability of a given user being online during a given time period") as recited in the independent claims 1, 24, 38, 39, 42, and 56.

The current Action states that col. 15, lines 56-65 of Marsh directs the weighting constants towards the user. Applicants respectfully disagree. Col. 15, lines 56-65 is directed towards the advertisement *distribution* scheduler of Marsh, whereas it is the advertisement *display* scheduler of Marsh that is in fact associated with the weighting constants. See col. 4, lines 7-16 of Marsh which recites:

> "The *advertisement display scheduler* computes a partial ordering (i.e., which should come first) between all pairs of advertisements in the advertisement queues. Such an ordering is sufficient to determine a total ordering on the entire set of advertisements. To determine which of two advertisements should be presented first, *the advertisement display scheduler computes a difference, or "delta," between the two advertisements with respect to a predetermined set of weighted scheduling criteria.* The algebraic sign of the sum of these differences indicates which of the advertisements should be shown first." (Emphasis Added).

Within the Action, there has been no suggested direct link between the advertisement distribution scheduler and the weighting constants of the advertisement display scheduler. Therefore, col. 15, lines 56-65 of Marsh cannot be relied upon to show that the weighting constants are, in fact, different than what is taught at Marsh, column 9, lines 44-49 and at Marsh, col. 11, lines 15-43 (that is, that the weighting constants are directed towards "characteristics of the advertisements").

Neither Dimitriadis nor Marsh teaches each and every claim element of independent claims 1, 24, 38, 39, 42, and 56. Therefore, the Office Action failed to establish a *prima facie* case of obviousness. Claims 1, 24, 38, 39, 42, and 56 are therefore patentable over the cited references.

(B) Further, it is respectfully submitted that col. 15, lines 60-61 of Marsh does not teach: "determining expected values relating to each user being online during a given time period" as recited in at least claim 1.

In fact, col. 15, lines 58-61 of Marsh recites:

"...the usage profile of the user (e.g., statistical information collected in the statistics log file at the user's computer 101) to ascertain expected *advertisement consumption* over a predetermined period." (Emphasis Added).

Applicants disagree with the current Action that "viewing advertising" or "advertisement consumption" of Marsh may be considered equivalent to "being online" as recited in claim 1, for several reasons. (1) Even if the definition given in paragraph 10 of the current action, e.g., "being online" is "served by or available through a system," is considered as the definition of "being online," there is no asserted link in the Action between this definition and "advertisement consumption." The Action simply asserts that "the user's action [advertisement consumption] in March et al. reads on [served by or available through a system]" without any further explanation or reasoning. (2) Clearly, on their face, "viewing advertising" and "advertisement consumption" are quite distinguishable from and cannot be considered as equivalent to "served by or available through a system." (3) Advertisement viewing and being online cannot be considered equivalent, because advertisements of Marsh may be viewed even when viewer is "off-line." For example, Marsh at col. 6, lines 66 to col. 7, line 1 recites: "The primary vehicle for presenting information, such as advertisements, to users during periods of *off-line* activity is the banner advertisement." (Emphasis Added). Because 'off-line' may be considered as opposite to 'online', "advertisement consumption" (whether or not during periods of off-line activity) cannot be considered to be equivalent to "being online."

For these additional reasons, neither Dimitriadis nor Marsh teaches each and every claim element of independent claim 1. Therefore, the Office Action failed to establish a *prima facie* case of obviousness. Claim 1 is therefore patentable over the cited references.

For the above reasons, Applicant respectfully requests that this rejection be withdrawn.

Claims 2-13, 15-23, 25-37, 40-41, 43-55, 57-59 depend, directly or indirectly, on one of claims 1, 24, 38, 39, 42, or 56, and are patentably distinguishable over the references respectively cited against them in the Office Action, for the reasons argued above. These

dependent claims are also patentable in view of the additional elements that they provide to the patentable combination.

Allowable Subject Matter

Claim 14 was objected to as being dependent upon a rejected base claim, but was indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 14 indirectly depends from claim 1. Because claim 1 is in condition for allowance, as discussed above; claim 14 is also allowable as originally submitted since they are dependant upon claims which are believed to be allowable. Applicants respectfully submit that claim 14 is in condition for allowance.

Claims 60-68 were indicated to be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 set forth in the Office Action. Accordingly, claims 60-68 have overcome the rejection under 35 U.S.C. § 112, and Applicants believe they are now in condition for allowance.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE
Serial Number: 09/767,793
Filing Date: January 23, 2001
Title: METHOD AND SYSTEM FOR SCHEDULING ONLINE TARGETED CONTENT DELIVERY

Page 19
Dkt 2050.004US1

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney, at (352) 373-8804 (Gainesville, Florida) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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